



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,178	06/02/2006	Kab-Sig Kim	5656BIO-1	3197
22442	7590	11/23/2011	EXAMINER	
SHERIDAN ROSS PC			DICKINSON, PAUL W	
1560 BROADWAY				
SUITE 1200			ART UNIT	PAPER NUMBER
DENVER, CO 80202			1618	
			MAIL DATE	DELIVERY MODE
			11/23/2011	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/596,178	KIM, KAB-SIG	
	<b>Examiner</b>	<b>Art Unit</b>	
	PAUL DICKINSON	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 August 2011.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) Claim(s) 1 and 3-20 is/are pending in the application.
  - 5a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 6) Claim(s) 1, 5-7, and 20 is/are allowed.
- 7) Claim(s) 3,4 and 8-19 is/are rejected.
- 8) Claim(s) \_\_\_\_\_ is/are objected to.
- 9) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) The specification is objected to by the Examiner.
- 11) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \*    c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Notes and Comments***

The Examiner attempted to contact Angela Domitrovich on 11/17/2011 to propose an Examiner's amendment but was unable to contact her.

Applicant's arguments, filed 8/30/2011, have been fully considered but they are not deemed to be fully persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objects are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Previously withdrawn claims 5-7 are rejoined and currently under consideration.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 3-4 and 8-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained.

Applicant argues that the specification gives sufficient guidance to allow the ordinary artisan to determine the scope of "rapidly cooling".

Applicant's arguments have been fully considered but are not found persuasive.

The phrase “rapidly cooling” is a relative term and is not defined by the claim or specification. The specification at pages 13-14 states:

“In the solidification of the mixture by rapid cooling, it is preferred to rapidly decrease the temperature of the solution of the melted mixture to the temperature of 10 °C or less. When cooling is conducted slowly, crystal growth of the active ingredients may occur, and under such circumstances, the nanoparticles of the active ingredients are hardly achieved and the obtained particles are likely to have a broad particle distribution.”

The rate of cooling is critical to the invention. If the cooling is not done at the proper rate, “crystal growth of the active ingredients may occur, and under such circumstances, the nanoparticles of the active ingredients are hardly achieved...”. Therefore the term “rapidly cooling” is not merely a broad term, but is narrow as the rate of cooling is critical to the invention, i.e. critical to producing the claimed nanoscale particles. However, the claims and specification give no guidance to what cooling rates prevent crystal growth (how rapid “rapidly cooling” must be), except for Examples 2-3, which teach “...the melted mixture was poured into a stainless steel plate which was precooled to 10 °C or less for rapid cooling and solidifying...”. As this is the only embodiment of “rapidly cooling” taught by the specification, the Examiner recommends adding this language to the claims, that is, "... the melted mixture is rapidly cooled by pouring the mixture into a stainless steel plate which was precooled to 10 °C or less...”. Such language would be definite.

### ***Allowable Subject Matter***

Claims 1, 5-7, and 20 are allowed.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DICKINSON whose telephone number is (571)270-3499. The examiner can normally be reached on Mon-Thurs 9:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/  
Supervisory Patent Examiner, Art Unit 1618

Paul Dickinson  
Examiner  
AU 1618

November 17, 2011